The remand being entered today was not written
for publication and is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ROBERT LEPAGE and MICHEL PARADIS

Appeal No. 2004-1166
Application No. 09/09/205,318[1]

REMAND TO EXAMINER

Before HARKCOM, Acting Chief Administrative Patent Judge, WILLIAM F. SMITH and NASE, Administrative Patent Judges.

Per curiam.

REMAND TO THE EXAMINER

The above-identified application is being remanded to the examiner for appropriate action.

[1] Application filed December 3, 1998, for reissue of U.S. Patent No. 5,579,820 (Application No. 08/339,175 filed November 10, 1994).

BACKGROUND

1. A review of the file record indicates that claims 20 to 27 have been rejected under 35 U.S.C. § 251 as attempting to recapture subject matter surrendered in the application to obtain the original patent.

2. A precedential opinion concerning a reissue recapture rejection under 35 U.S.C. § 251 was decided May 29, 2003 in Ex parte Eggert, 67 USPQ2d 1716 (Bd. Pat. App. & Int. 2003). In Eggert, the majority opinion applied the fact-specific analysis set forth in In re Clement, 131 F.3d 1464, 1468-71 45 USPQ2d 1161, 1164-66 (Fed. Cir. 1997), determined that under the facts and circumstances before it, the "surrendered subject matter" was claim 1 of Eggert as that claim existed prior to the post-final rejection amendment that led to the allowance of claim 1 in the original patent, and decided that reissue claims 15-22 of Eggert were not precluded (i.e., barred) by the "recapture rule." 67 USPQ2d at 1730-33.

3. On September 23, 2003, an Examiner's Answer in this reissue application was mailed (Paper No. 8). A review of the Examiner's Answer reveals that there is insufficient evidence that an appeals conference was conducted by the examiner. The Manual of Patent Examining Procedure (MPEP) § 1208 (8th Ed., Rev. 1, 2003) states:

> On the examiner's answer, below the primary examiner's signature, the word "Conferees:" should be included, followed by the typed or printed names of the other two appeal conference participants. These two appeal conference participants must place their initials next to their name. This will make the record clear that an appeal conference has been held. (Emphasis added).

This Answer does not contain the appropriate initials placed by the conferees as required above.

4. On December 4, 1998, the appellant filed an Information Disclosure Statement (IDS). As noted by the signed, initialed and dated IDS in the file, the examiner considered the IDS on May 13, 1999. However, the IDS has not been made of record to the file (e.g., assigned a paper number) nor do we find any indication in the record that the examiner has properly notified the appellant of his consideration of the IDS or sent a copy of the initialed and dated IDS to the appellant.

ACTION

We remand the application to the examiner for:

1. Determining whether the rejection under 35 U.S.C. § 251 remains appropriate in view of Ex parte Eggert.

If the examiner determines that the rejection under 35 U.S.C. § 251 remains appropriate, the examiner is authorized to prepare a supplemental examiner's answer specifically addressing the § 251 rejection and to respond to the argument raised in the reply brief (Paper No. 19, filed December 1, 2003). See 37 CFR § 1.193(b)(1). In the event that the examiner furnishes a supplemental answer, the appellant may file a reply brief in accordance with 37 CFR § 1.193(b)(1).

If the examiner determines that the rejection under 35 U.S.C. § 251 is no longer appropriate, the examiner should withdraw the rejection in an appropriate Office action.

2. Taking corrective action regarding the appeals conference, by having the conferees place their initials next to their typed name.

3. Sending proper notification to the appellant of consideration of the IDS filed December 4, 1998.

CONCLUSION

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01.

If after action by the examiner in response to this remand there still remains a decision of the examiner being appealed, the application should be promptly returned to the Board of Patent Appeals and Interferences.

GARY V. HARKCOM
Acting Chief Administrative Patent Judge

WILLIAM F. SMITH
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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